

## REMARKS/ARGUMENTS

Claims 1, 2, 5 – 12, 15, and 17 – 22 are pending in this case. Claims 1, 2, 5 – 12, 15, and 17 – 21 are presented for re-examination in view of the following comments. Claim 22 is newly presented for a first action on the merits. By this Response and Amendment, claims 3, 4, 13, 14, and 16 are cancelled without prejudice or disclaimer.

In the Outstanding final Office Action (hereinafter “the October 20 Office Action”), the Examiner rejected claims 1 – 15 and 18 – 21 under 35 U.S.C. §112, second paragraph as being indefinite; and rejected claims 1 – 21 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,775,799 to Giorgetta et al. (hereinafter “Giorgetta”).

A response to the October 20 Office Action was filed on January 19, 2007 (hereinafter “the January 19 response”) but never entered. An interview was subsequently conducted on January 31, 2007 (hereinafter “the January 31 interview”) to discuss the amendments proposed in the January 19 response.

In the January 31 interview, the Examiner indicated that claims 1, 2, 5 – 12, 15, and 18 – 21 would be allowable if amended in the manner proposed in the January 19 response. This indication of allowable subject matter is noted with appreciation.

By this Response and Amendment, claims 1, 2, 5 – 12, 15, and 18 – 21 are provided with the same amendments presented in the January 19 response. Specifically, Applicants have amended claim 1 to include the features of original claims 3 and 4, which have accordingly been cancelled without prejudice or disclaimer, and have amended claim 18 to include the features of original claim 14, which has accordingly been cancelled without prejudice or disclaimer. Claims 15 and 17 are further amended to depend from allowable claim 18. Claims 13 and 16 are cancelled without prejudice or disclaimer. Claim 22 is newly presented, and contains features of

previous claims 15 and 17 but presented in the language of allowable claim 1. The claims have further been amended to obviate all rejections under Section 112, second paragraph.

Accordingly, the rejection of the claims as being anticipated by the Giorgetta is expressly and specifically traversed and reconsideration of this rejection is requested in view of the comments and arguments set forth below.

It is respectfully submitted that the above amendments to claims 1, 2, 6, 11, 13, 16, 18, and 21, and the presentation of new claim 22, do not introduce any new matter to this application within the meaning of 35 U.S.C. §132. Support for these amendments may be found, *inter alia*, in original claims 3 (“producing the service packets forming one or more service flows...at the source adaptation element based on at least one of the following two operations; monitoring the information flow and monitoring external instructions”) and 4 (“service packets compatible with the information packets are suitable for multiplexing with one another”), and in the specification as published, including *inter alia* at paragraph 0041 (“introducing various types of the service packets forming the above-mentioned so-called service flows”), at paragraph 0056 (“providing a signaling channel intended for performing one or more signaling functions at the Ethernet level”) and at paragraph 0030 (“preserving the signaling channel at the Ethernet level.”) Support for new claim 22 may be found in claims 15 and 17 as originally filed, and in the passages from the specification noted above.

#### **REJECTIONS UNDER 35 USC §112, SECOND PARAGRAPH**

In the Outstanding final Office Action, the Examiner rejected claims 1 – 15 and 18 – 21 under 35 U.S.C. §112, second paragraph as being indefinite.

## RESPONSE

By this Response and Amendment, Applicants have amended the claims to provide the requisite wording specified by the Examiner.

Applicants submit that these amendments obviate the Examiner's rejection under 35 U.S.C. 112, second paragraph.

## REJECTIONS UNDER 35 USC §102(e) and ALLOWABLE SUBJECT MATTER

In the Office Action, the Examiner rejected all outstanding claims as being anticipated by Giorgetta.

In the Interview of January 31, 2007, the Examiner indicated that the above amendments to claims 1, 2, 5 – 12, 15, and 18 – 21, first proposed in the January 19 response, would place these claims in condition for allowance.

## RESPONSE

Reconsideration and withdrawal of the rejections is requested.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

The foregoing amendments to claims 1, 2, 5 – 12, 15, and 18 – 21 are identical to those proposed in the January 19 response, and are believed to place these claims in condition for

allowance, as they include features which are not disclosed, taught, or suggested in Giorgetta. Moreover, claims 15 and 17 have been amended to depend from claim 18, which is believed to be in condition for allowance.

As the Examiner indicated that claims 13 and 16 did not “appear allowable at this time,” Applicants have cancelled these claims without prejudice or disclaimer.

The following arguments, which distinguish the present claims from Giorgetta, are reproduced from the January 19 Response.

Applicants submit that, in comparison with the invention claimed in amended Claims 1 and 16, the Giorgetta reference (as well as the previously cited Naveh reference and other cited references) does not describe or suggest creating or using at least one service flow **formed at the Ethernet level** from **service packets into which data on signaling functions have been introduced**, whose packets are **multiplexed with an information Ethernet packet flow**.

Applicants further submit that, in comparison with the invention claimed in amended Claim 2, the Giorgetta reference (as well as the previously cited Naveh reference and other cited references) does not describe or suggest a **source adaptation element** which produces **service flows at the Ethernet level**, or the step of **multiplexing the service packets of said one or more service flows with the information packets of the information flow**.

While the Examiner cites col. 8 lines 64 et seq. of Giorgetta as anticipating the feature of “service packets,” Giorgetta nowhere describes producing **service packets** which **“carry [an] indication of a...signaling function,”** nor suggests any indication of a **service function** in such packets, nor suggests **service packets multiplexed with an information Ethernet packet flow**. Therefore, Giorgetta cannot anticipate the present invention as claimed herein.

In contradistinction, Giorgetta proposes “engaging”, in the fast Ethernet traffic, performance monitoring operations, such as Forward Error Correction (FEC) operation known for many optical networks protocols (SONET, SDH, OTN). The operations of performance monitoring of the Ethernet traffic, as they are described and illustrated in the Giorgetta reference, comprise monitoring the Ethernet traffic (see block 30 in Fig. 3) but do not produce any packet flow (service flow) which would be combined/multiplexed with packets of the Ethernet traffic (information flow). The above fact is demonstrated by the “dead ends” of box 30 of Fig. 3 and of box 205c of Fig. 6: they do not have outgoing arrows which would mean combining any new flow with the existing data traffic.

The Giorgetta’s term “engaging” can be understood only in the meaning of applying, since any other meaning has no support in the Giorgetta’s description in its specification.

The maximal influence of the monitoring results which can be understood from studying the Giorgetta reference is that, for example, in the FEC operation, a continuous sequence of bits (**not packets**) is produced while monitoring information packets, and such bits are some how introduced into packet headers of the monitored informational packets (FEC processing of any information stream is followed by encoding that information stream).

As has been mentioned in the response to the previous Office Action, the modification if at all performed at the Ethernet level, relates to a known standard functionality at the Ethernet level, according to which the informational packets are changed depending on the errors in the Ethernet traffic.

The Giorgetta reference, similarly to the previously cited Kalman reference, mentions that data in the information stream can be modified (for example, headers of the packets can be modified). In the Kalman reference, where we could assume that the “modification” is

performed at the Ethernet layer, Giorgetta modifies SDH frames at the SDH/SONET layer; however, both in Kalman and in Giorgetta, no additional/separate service packet flow is created; any modifications affect the informational packets/frames/streams themselves.

Contrary to that, **the present invention, as set forth in the presently amended claims, proposes forming a separate flow of additional service packets to be transmitted together (in a combined packet flow) with the informational packets at the Ethernet level - and does not propose modifying informational packets.**

The Examiner continues to contend that Giorgetta describes combining (interleaving) information and service flows.

With respect, it is submitted that this contention is incorrect.

Firstly, since Giorgetta does not describe service packet flows, he cannot describe such interleaving.

Secondly, **what Giorgetta describes is the interleaving of informational flows.**

Fig. 6 and the related description disclose that Giorgetta modifies information flows at the SDH/SONET layer (block 205b). Giorgetta interleaves ndata streams (block 216) which, in any possible combination, are information streams. Moreover, the informational flows are combined at the SDH/SONET level. The GBE performance monitoring 205c does not produce any additional packet flow - see the "dead end" of block 205c in Fig. 6 and the similar "dead end" of the block 30 in Fig. 3).

**Giorgetta neither describes nor suggests providing any signaling/service packet flow at the Ethernet layer, and, consequently, does not and cannot propose interleaving/combining such a service packet flow with any of the mentioned informational flows.**

In view of the above arguments, Claim 1 should be considered patentable over the cited prior art of record.

In section 8g of the Office Action, the Examiner discusses his rejection of Claim 2. The Applicants disagree with the Examiner's criticism of Claim 2. At least in view of the above arguments, Claim 2 is patentable. Moreover, the Examiner refers to Figures 2,3,6 and the Abstract of Giorgetta, through neither of them describes/suggest providing operating points between any network domain and an Ethernet network (device), and definitely the cited figures/abstract do not describe the specific equipment of such operating points, as described in Claim 2.

In paragraph 20 of the Office Action, the Examiner discusses his rejection of Claim 3. In respect to Claim 3, the Giorgetta reference might describe producing any succession of binary information based on monitoring SDH/SONET information stream (the paragraph bridging col. 9 and col. 10 of Giorgetta). However, no **service/signaling packets are formed by Giorgetta** from that binary information; that information is used for modifying the same information flow.

In a similar way, all of the remaining Examiner's rejections become null and void at least in view of the arguments presented with respect to amended Claim 1. For example, in section 8i, the Examiner criticizes Claims 11 and 12 by again referring to Giorgetta. However, as in Claim 1, the Examiner overlooks the fact that Giorgetta speaks about the **information** packets/frames, while the present invention claims inserting an indication of a service function into the newly created **service packets into which data on signaling functions have been introduced**, which are **multiplexed with the information packets**.

### NEWLY PRESENTED CLAIM

In the January 31 interview, the Examiner indicated that claims 13, 16, and 17 did not appear to be allowable in their present form, but that these claims might be allowable in a combination.

Accordingly, Applicants have combined features of claims 15 and 17 into new claim 22, but have set forth the claimed features in the allowable wording of claim 1.

Applicants submit that claim 22 is allowable over the cited prior art patents, as they, alone or in combination, fail to disclose, teach, or suggest the features of new claim 22. Specifically, claim 22 includes the distinguishable features discussed in the January 31 interview, such as: a source adaptation element comprising “a source function block for producing service packets multiplexable with ... *outgoing Ethernet information packets based on results of ... monitoring*, which introduces into the service packets data about said one or more signaling functions;” and a sink adaptation element comprising “a de-mapping block which ... de-maps the received frames of [a] transport network thus obtaining therefrom [an] incoming combined flow composed from an incoming information flow of information Ethernet packets and *one or more incoming service flows formed from service packets multiplexed with the information packets of the Ethernet incoming flow.*” (Present Application, Claim 22, emphases added)

Accordingly, as the cited prior art fails to disclose, teach, or suggest the features of new Claim 22, entry and allowance of this claim are requested.

### NONOBVIOUSNESS OF CLAIMS

A rejection under Section 102 inferentially could include a rejection under Section 103. However, it is submitted that all of the present claims are not obvious over the the Giorgetta



reference at least for the reasons cited above. This reference, either taken alone or with other references of record, does not teach, discuss, or suggest the present invention as now claimed.

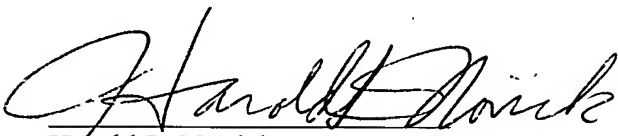
### CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Charge any fee deficiency or credit any overpayment to Deposit Account: No. 14-0112.

Respectfully submitted,

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